

### **REMARKS**

Claims 43-61 are pending herein. By this Amendment, Claims 28-42 are canceled; and Claims 43-61 are added. Support for the new claims is found in the specification at, *inter alia*, page 6, line 31 - page 7, line 3; page 10, lines 30-32; page 12, lines 4-6; page 13, lines 18-25; and in the Examples. No new matter is added by this Amendment.

#### **I. Summary of Examiner Interview**

Applicant thanks Examiner Zimmerman for the courtesies extended to his representative at the February 18, 2010 personal interview. At the interview, the adhesive-repellant base medium was first discussed. The Examiner maintained that the Temporary Liner of Berg may be considered adhesive-repellant because it assertedly has the same function as the claimed adhesive-repellant base medium. Applicant's representative maintained that the steps of Berg may not simply be inverted. For example, Berg and Olsen required that transparent beads sink into a thermoplastic layer. Inverting the process would not allow the beads to be spatially fixed as required by the cited art and would hinder the formation of a motif. The Examiner then asserted that one of skill in the art could simply "move" the thermoplastic layer in conjunction with the pigmented bead-bind layer to fix such transparent beads. The obviousness rejection was discussed, with Applicant's representative maintaining that it was improper as will be discussed in greater detail below.

#### **II. Formality Matters**

Claims 28-42 were rejected under 35 U.S.C. 112, first paragraph, as assertedly not having an adequate written description. Claims 28-42 are canceled, thereby rendering the rejection moot.

Nevertheless, Applicant respectfully notes that to satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had

possession of the claimed invention. It is axiomatic that there is no *in haec verba* requirement (MPEP 2163).

One of ordinary skill in the art would readily appreciate that Applicant was in possession of the claimed invention. Accordingly, the written description requirement of 35 U.S.C. 112, first paragraph, is satisfied. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 28-42 were rejected under 35 U.S.C. 112, second paragraph, as assertedly being indefinite. Claims 28-42 are canceled, thereby rendering the rejection moot. Reconsideration and withdrawal of the rejection are respectfully requested.

### III. Rejections Under 35 U.S.C. 103(a)

Claims 28-30 and 32-42 were rejected under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 3,172,942 (Berg) in view of U.S. Patent No. 3,420,597 (Nellessen et al.) and U.S. Patent No. 5,916,399 (Olsen et al.). Claims 28-42 are cancelled. However, this rejection is respectfully traversed with respect to the pending new claims.

#### A. The Claimed Methods Produce a New Result

According to MPEP 2144.04 (IV)(c), the selection of any order of performing process steps is *prima facie* obvious in the absence of new or unexpected results.

The pending claims recite that the steps must be performed “in sequence”. As shown by the attached 1.132 Declaration, the steps in the claimed methods allow a motif to be imprinted with a plan view of its correct side (i.e., not in a mirror-reversed fashion as required by the cited art). Thus, the claimed methods produce a new result.

The 1.132 Declaration also shows that the steps of Berg may not simply be inverted as asserted by the Examiner. For example, inverting the structure of Berg as would require that the transparent beads 14 would have to arrange themselves onto the pigmented bead-binder layer 16, instead of sinking into the thermoplastic carrier coating 12 as required by Berg. As a result, a plurality of transparent beads would not be anchored or fixed in a spatially constant position. Thus, it would not be possible to print

an imagewise pattern onto such non-fixed microspheres, as required by Olsen et al. (color layer 22, see col. 4, lines 13-20 and FIG. 1).

At the interview, the Examiner asserted that one of skill in the art could simply “move” the thermoplastic layer in conjunction with the pigmented bead-bind layer (without providing any indication of how this could be done) or combine the beads and binder layer together in view of Nellessen et al. However, combining the transparent beads 14 and pigmented bead-binder layer 16 would result in the pigmented bead-binder layer also lying on the top and the side of the transparent beads in the final product. Consequently, the pigmented bead-binder layer would obstruct a view to the transparent beads and the reflective properties would be at least partially destroyed. Furthermore, involving the bead/binder mixing according to Nellessen et al. would require a final etching step in order to remove the reflecting surface, which however could not be realized in the field of textile transfers (please note that Nellessen et al. relates to the field of painted signs, see col. 2, lines 41-44).

For all of these reasons, the selection and order of the claimed process steps are not *prima facie* obviousness.

#### B. The Obviousness Rejection in View of KSR is Improper

To support a rejection under 35 U.S.C. 103(a), it is not enough merely to cite to *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007) and argue that the claimed invention is “common sense”.

First, as noted in *KSR*, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* at 418.

Second, the Examiner has not complied with the required analysis for applying different rationales under KSR according to the Federal Register Vol. 72, No. 195 (October 10, 2007). See also MPEP 2143. For example, regarding common sense obviousness rejections, it must be demonstrated that: (1) there a design need or market pressure to solve a problem; (2) there are a finite number of identified, predictable

solutions; and (3) one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success.

The Examiner has not demonstrated any design need or market pressure to solve any problems with a mirror-reversed motif. In fact, the Examiner acknowledges that all the cited art is directed to such mirror-reversed motifs (Office Action bridging pages 5-6). In stating that there is a need for transfers comprising a motif imprinted with a correct side in a plan view, the Examiner is merely restating a problem that is acknowledged and solved within Applicant's own specification. It is axiomatic that the Applicant's own specification may not be considered prior art. The reason for this is to prevent hindsight reconstruction. However, such hindsight reconstruction is exactly what is happening with the present application. Using the claimed methods as a blueprint, the Examiner inverts and changes the process steps of Berg, Olsen, and Nellessen without any reason other than to reconstruct the claimed methods.

In addition, the Examiner has not pointed to any finite number of identified and predictable solutions, with a reasonable expectation of success. Again, as acknowledged by the Examiner, all of the cited art is directed to mirror-reversed motifs. There has been no showing of any identified and predicted solutions for a motif imprinted with a correct side in a plan view (except with impermissible reference to Applicant's specification). Further, as established in the 1.132 Declaration, the method of Berg is quite distinct from that claimed and cannot simply be inverted with a reasonable expectation of success. Nor would one of ordinary skill in the art have recognized the complete restructuring of Berg in view of Olsen et al. and Nellessen et al. as an "identified and predictable solution" to achieve the claimed motif imprinted with a plan view of its correct side. Accordingly, it would not have been obvious for one of ordinary skill in the art to practice the claimed methods in view of the combined teachings of Berg, Nellessen et al. and Olsen et al. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 31 was rejected under 35 U.S.C. 103(a) as obvious over Berg in view of Nellessen et al., Olsen et al., and assertedly Applicant's Admitted Prior Art. Claim 31 is

cancelled, thereby rendering the rejection moot. Reconsideration and withdrawal of the rejection are respectfully requested.

C. Secondary Considerations: Related Patent Grants

Applicant respectfully notes that several foreign patents have been granted from the PCT application on which the present U.S. national stage application depends:

1. Canada: CA2346984;
2. Europe: EP1137546;
3. Australia: AU756160;
4. Korea: KR10-0473741-0000; and
5. China: CN1137822.

This fact should be given probative weight in examination of the present application, especially in view of the fact that Canada, Europe, Australia, and Korea are all Intellectual Property Offices that could serve as a basis for the Patent Prosecution Highway (PPH).

Although the U.S. Patent and Trademark Office may have different standards for patentability than these IP Offices, such IP Offices also have different standards for patentability from each other. Therefore, it is quite remarkable that the subject matter of the present patent application has been recognized as patentable across many and diverse foreign Intellectual Property Offices. It is respectfully noted that such objective evidence relevant to the issue of obviousness, i.e., secondary considerations, must be considered and given weight by the U.S. Patent and Trademark Office as one of the *Graham* factors, which were reaffirmed in *KSR* (MPEP 2141).

IV. Conclusion

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

/Warren Zitlau/

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Date: March 8, 2010